

REMARKS

Claims 1-48 were pending in the Office Action. Upon entry of the present paper, these claims remain pending, independent claim 42 is unchanged, and claims 1, 7, 19, 41 and 45-47 are amended. Applicants submit this paper in the hopes of clarifying an issue that does not appear to have been addressed in the Office Action, to note that one of the references cannot qualify as prior art, and to hopefully place this application in condition for allowance.

In the Office Action, claims 1-18, 20, and 23-48 stand rejected under 35 U.S.C. 103(a) as being unpatentable over an alleged combination of Nakata et al. (U.S. Patent Application Publication No. 2003/0091329) and Silverbrook et al. (U.S. Patent No. 6,831,682); claims 21-22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over an alleged combination of Nakata et al., Silverbrook et al. and Yanagita (U.S. Patent Application Publication No. 2004/0218902). Claim 19 also stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite, although this rejection is believed to be rendered moot upon entry of the present paper.

As an initial matter, Yanagita does not appear to qualify as prior art. The present application claims priority to December 28, 2000. Yanagita was published in 2004, well after Applicants' 2001 filing date, so it cannot qualify under 35 U.S.C. 102(b), and Yanagita's earliest U.S. filing date is February 7, 2001, after Applicants' priority date, so Yanagita cannot qualify under 35 U.S.C. 102(e). At a minimum, the rejections of claims 21 and 22 cannot be properly maintained.

Turning to the art-based rejections, independent claim 42 has not been amended herein, and recites, among other features, "wherein said image and version of the image

comprising the visual effect are displayed, after the receiver receives the image data and associated information, in a predetermined sequence to convey a meaning associated with a context of the image” (emphasis added). To show such a feature in the cited art, the Office Action refers to the rejection of claim 1, but claim 1 did not recite the “predetermined sequence” found in claim 42. Accordingly, there is no discussion in the Office Action of where this recited predetermined sequence is found in the cited art. Applicants respectfully submit that the cited art fails to teach or suggest such a predetermined sequence.

In the discussion rejecting claim 1 (applied by reference to claim 42), the Office Action alleges that Silverbrook et al. (at col. 45, line 65 to col. 46, line 2) teaches that “the image can be reproduced with or without the artistic effect.” Office Action, p. 3. There is no teaching or suggestion, however, of actually displaying the image with and without the artistic effect, or of the recited predetermined sequence of display.

Furthermore, there is no teaching or suggestion of the recited predetermined sequence “to convey a meaning associated with a context of the image,” as also recited in independent claim 42. Although the Office Action does cite Silverbrook et al. col. 35, lines 24-26 for an alleged context (in rejecting claim 48), that portion does not teach or suggest the predetermined sequence and meaning associated with a context of the image, as recited. Instead, that portion uses the word “context” to refer to a “context for the user input” (col. 35, line 22-23), and does not describe it as the recited “context of the image.”

The other references do not overcome these deficiencies. For example, the Office Action already concedes that Nakata et al. fails to teach or suggest displaying “the image without said visual effect on the display” (Office Action, p. 3, quoting claim 1), so

Nakata et al. certainly fails to teach or suggest the predetermined sequence recited in claim 42. The other reference, Yanagita, is not prior art.

If this rejection is to be maintained on appeal, Applicants request clarification as to where the references show such a predetermined sequence, and what context of the image is in these references.

For at least the reasons above, independent claim 42 is distinguishable over the applied references and Applicants respectfully submit that the current rejection would not survive appeal. The other independent claims 1, 7, 41, 45 and 46 are amended herein to recite a “predetermined sequence,” and are also distinguishable. The remaining claims depend from one of these independent claims, and are distinguishable for at least the same reasons as their respective base claims, and further in view of the various features recited therein. For example, claims 47 and 48 also recited a “predetermined sequence,” but the Office Action does not cite to where these features are allegedly shown in the cited references.

Conclusion

For at least the foregoing reasons, the pending claims are believed to distinguish over the applied references. If, however, the Examiner feels that additional discussion and/or amendment would be helpful, the Examiner is invited to telephone the Applicants' undersigned representative at the number appearing below.

Respectfully submitted,

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